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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/558,117 | 04/25/2000 | David L Patton | 81003F-P | 9422 |

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PATENT LEGAL STAFF
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EXAMINER

KIM, CHONG R

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|-------------------------------|-------------------------------|--|
| Advisory Action | Application No. 09/558,117 | Applicant(s) PATTON ET AL. | |
| | Examiner Charles Kim | Art Unit 2623 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 112 first paragraph enablement rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 10.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Jon Chang
Primary Examiner

Continuation of 5. does NOT place the application in condition for allowance because: Applicants argue (page 7) that the 112 first paragraph (written description) rejection is not applicable because pages 13 and 14 of the applicant's specification disclose the claimed features. The Examiner disagrees. The cited portions of the applicant's specification indicates that the captured digital image of the person 125 and the unique identification number 50 is transmitted to the central location. Nowhere does it state that the image on the document and the image of the presenter is transmitted to the central location and compared to the stored image at the database. Applicants also refer to page 9, lines 21-28 for disclosing the claimed features. The Examiner notes that the cited portions of page 9 indicate that the system is capable of sending a hardcopy image of the user to the central location during an initialization process (Note that the transmitted image is stored in the database for use in subsequent authentication processes). However, nowhere does it state that the image on the document and the image of the presenter is transmitted to the central location and compared to the stored image at the database. The Examiner notes that the hardcopy image that is transmitted to the central location during the initialization step (as described on page 9) is the stored image at the database. The subsequent authorization process compares this stored image with the transmitted captured image of the person and the unique identification number (pages 13-14). The Examiner notes that neither of the cited portions of the applicant's specification indicate the step of "comparing the image on the document and an image of the presenter as obtained by a camera at said remote location with the stored image at said database associated with said first unique ID" as claimed. Accordingly, the 112 first paragraph written description rejection appears to still be applicable.

In response to applicant's argument (page 8) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion/motivation for combining Rhoads and Zdybel would have been to enhance the authentication process by providing additional information (indicia) that could be used to verify the presenter's document. Furthermore, the suggestion/motivation for combining Rhoads, Zdybel, and Cadorette would have been to enhance the reliability of the authentication process (Cadorette, col. 2, line 60-col. 3, line 2).